

**REQUEST FOR WITHDRAWAL OF FINALITY**

On page 10 of the Office action, the Examiner asserts that the present action is made FINAL per section 706.07(b) of the MPEP.

Although, section 706.07(b) of the MPEP states that claims of an application for which an RCE has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE when certain conditions are met, it further states that it would NOT be proper to make final a first office action after RCE where the application contains material which was presented after final and entry was denied because “new issues were raised that required further consideration and/or search.”

In the present case, Applicants submitted amendments after final on April 22, 2011 and the Examiner issued an Advisory Action on May 25, 2011 denying entry of the proposed amendments because “[t]hey raise new issues that would require further consideration and/or search.” Accordingly, Applicants filed an RCE requesting the April 22, 2011 amendments be entered.

As a result, the finality of the present Office action is improper. Applicants respectfully request reconsideration and withdrawal of the finality of the present action. In addition, Applicants submit herewith a response to Action.

### **REMARKS**

Claims 1-5, 7-9, 14-18, and 20-26 are currently pending, wherein claims 4, 5, 17 and 18 are withdrawn from consideration. Favorable reconsideration is respectfully requested in view of the remarks presented herein below.

In paragraph 9 of the final Office action ("Action"), the Examiner rejects claims 1-3, 7-9, 14-16, and 20-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0195700 A1 to Hamada et al. ("Hamada") in view of U.S. Patent Application Publication No. 2004/0201501 to Daizen ("Daizen"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some rationale to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-3, 7-9, 14-16, and 20-26 are patentable over the combination of Hamada and Daizen for at least the fact that the combination fails to disclose or suggest a display unit configured to display, in order of the route, some of the intersection (claims 1-3 and 6-9) or connecting road (claims 14-16 and 19-22) names for selection by a user, on a part of a screen and simultaneously display a map for route guidance on another part of the screen, and/or a facility searching unit configured to search for facilities which exist in a vicinity of the intersection (claims 1-3 and 6-9) or connecting road (claims 14-16 and 19-22) designated by the user.

Hamada discloses a navigation apparatus which displays information concerning facilities which are present in a broad range ahead of a user. An information processing section 4 of the navigation apparatus identifies a facility type to be displayed. Then, a predicted road along which a user is expected to travel is determined, and a reference intersection is selected from among the intersections on the predicted road. The information processing unit 4 computes a network of roads beginning from the selected reference intersection, and acquires facility information in the neighborhood thereof. Fig. 4 is a flowchart illustrating the details of the reference intersection selection process performed by the processing unit 4. As described in paragraph [0077], the determination as to whether an intersection is a reference intersection or

not is based on whether or not the intersection satisfies a predetermined condition (e.g., is the intersection on the predicted road, it is the closest intersection to the current location). However, nowhere in Hamada is there any disclosure or suggestion of allowing the user to designate/select the reference intersection. To the contrary, according to Hamada, the selection of an intersection is performed automatically by the navigation apparatus according to the predetermined condition, not designated by the user as claimed. Therefore, Hamada cannot be found to disclose or suggest a display unit configured to display, in order of the route, some of the intersection/connecting road names for selection by a user, on a part of a screen and simultaneously display a map for route guidance on another part of the screen or a facility searching unit configured to search for facilities which exist in a vicinity of the intersection/connecting road designated by the user.

Daizen discloses an intersection search apparatus that searches for intersections in the vicinity of a facility. As shown in Fig. 3, step ST3 of Daizen, a facility genre or a feature point, such as a pedestrian overpass, monument, or three-forked road, is selected first, then a search for intersections having facilities of the selected facility type nearby is performed. In addition, a list of the intersections found by the search is displayed. However, nowhere in Daizen is there any disclosure or suggestion of allowing a user to designate an intersection and then searching for facilities which exist in the vicinity of the designated intersection or connecting road.

In response to Applicants arguments, the Examiner points to the feature point or genre “three-forked road” illustrated in Fig. 4 and discussed in paragraph [0024] of Daizen as disclosing that the user may search by “three-forked road.” Although, Daizen may disclose allowing the user to select feature points in which to search for intersections, the feature point “three-forked road” is not equivalent to displaying a list of intersection/connecting road names for selection by the user as claimed.

Since Hamada and Daizen both fail to disclose or suggest a display unit configured to display, in order of the route, some of the intersection/connecting road names for selection by a user, on a part of a screen and simultaneously display a map for route guidance on another part of the screen or a facility searching unit configured to search for facilities which exist in a vicinity of the intersection/connecting road designated by the user as claimed, the combination of these two references cannot possibly disclose or suggest said elements. Therefore, even if,

*arguendo*, one skilled in the art had some rationale to combine Hamada and Daizen (which Applicants do not concede), the combination would still fail to render claims 1-3, 7-9, 14-16 and 20-26 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle Reg. No. 46,607 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: November 2, 2011

Respectfully submitted,

By Penny Caudle #46,607  
D. Richard Anderson  
Registration No.: 40439  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road, Suite 100 East  
P.O. Box 747  
Falls Church, VA 22040-0747  
703-205-8000